REMARKS

The present Amendment amends claims 1, 3, 5, 9, and 10, leaves claims 2, 4, 6 and 7 unchanged, and cancels claim 8. Therefore, the present application has pending claims 1-7, 9 and 10.

Allowable Subject Matter

Claims 5-7 and 10 stand objected to as being dependent upon a rejected base claim. As such, the Examiner indicated that claims 5-7 and 10 would be allowable if rewritten in independent form including all the limitations of the base claim and any intervening claims. Applicants have amended the claims, such that claims 5 and 10 are independent claims and contain all the limitations of their respective base claims and any intervening claims. Therefore, claims 5-7 and 10 are in condition for allowance.

35 U.S.C. §102 Rejections

Claims 1-3 and 9 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Application Publication No. 2004/0117831 to Ellis, et al. ("Ellis"), where the Examiner notes that Ellis incorporates by reference in its entirety Application Serial No. 09/356,270 (now abandoned) to DeWeese, et al. ("DeWeese").

I. A Single Prior Art Reference Must Teach Every Element of the Claims

The Examiner has rejected claims 1-3 and 9 as being anticipated by Ellis, but the Examiner relies upon both Ellis and DeWeese in the rejection. As indicated in MPEP 2131, a claim is anticipated only if each and every element as set forth in the

claim is found, either expressly or inherently described, ***in a single prior art reference*** (citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Exceptions to this rule of law are described in MPEP 2131.01, which reiterates that normally, only one reference should be used in making a rejection under 35 U.S.C. §102. A rejection over multiple references has been held to be proper when the extra references are cited to: (a) prove the primary reference contains an "enabled disclosure"; (b) explain the meaning of a term used in the primary reference; or (c) show that a characteristic not disclosed in the reference is inherent. The Examiner's reliance upon DeWeese does not fall into to any of the three categories. In fact, Application Serial No. 09/356,270 to DeWeese is merely cited in Ellis to describe additional features of an illustrative chat system (see paragraph [0216] of Ellis). Therefore, the rejection of claims 1-3 and 9 is defective and should be withdrawn.

II. The DeWeese Publication Relied Upon Was Not Incorporated by Reference

The Examiner relies upon U.S. Patent Application Publication No. 2005/0262542 for Application Serial No. 10/918,753 to DeWeese in the rejection under 35 U.S.C. §102(e). Notwithstanding that the anticipation rejection is defective for the reasons previously discussed, Applicants further submit that U.S. Patent Application Publication No. 2005/0262542 for Application Serial No. 10/918,753 to DeWeese was not incorporated by reference in Ellis. To the contrary, parent Application Serial No. 09/356,270 (now abandoned) to DeWeese was incorporated by reference in Ellis (see paragraph [0216] of Ellis). Therefore, in addition to

improperly relying upon multiple references in an anticipation rejection, the Examiner also relies upon a publication that has not been incorporated by reference into Ellis.

It should be noted that by these remarks, Applicants do not concede that the use of multiple references is appropriate, except for in the limited circumstances previously discussed. And these limited circumstances do not include use of a second reference in an anticipation rejection, where the second reference relied upon was incorporated by reference in a primary reference, or more specific to the present Office Action, where the second reference relied upon is a continuation of an abandoned application incorporated by reference. However, because the Examiner appears to use the alleged incorporation by reference to justify the use of multiple references in this rejection, Applicants found it worth noting that the document relied upon is not the document incorporated by reference. Therefore, the rejection of claims 1-3 and 9 should be withdrawn.

III. Neither Ellis Nor DeWeese Teach or Suggest Every Element of the Claims

Notwithstanding that the Examiner's rejection under 35 U.S.C. §102(e) is defective for the reasons previously discussed, the rejection with respect to claims 1-3 and 9 is traversed for the following reasons. Applicants submit that the features of the present invention, as now more clearly recited in claims 1-3 and 9, are not taught or suggested by Ellis, whether taken individually, or in combination with any of the other references of record. Therefore, Applicants respectfully request the Examiner to reconsider and withdraw this rejection.

Amendments were made to the claims to more clearly describe the features of the present invention. Particularly, amendments were made to the claims to more clearly describe that the invention is directed to a multi-user talking system and a method of multi-user talking for providing a multi-user talking service among viewers of content as recited, for example, in independent claims 1 and 9.

The present invention, as recited in claim 1 and as similarly recited in claim 9, a multi-user talking system and a method multi-user talking for providing a multi-user talking service among viewers of content. The multi-user talking system includes a content distribution apparatus and a multi-user talking control apparatus, where each apparatus is connected to terminals of viewers through a network. The content distribution apparatus includes a request-for-viewing receiving means for receiving a request for viewing the content from a terminal of a viewer, and a viewer management means for managing the request for viewing received by the request-for-viewing receiving means. The viewer management means associates the request with a transmission source address of the request for viewing. The content distribution apparatus also includes a content distribution means for distributing the content to a transmission source address managed by the viewer management means, through the network. Also, in the present invention, the multi-user talking control apparatus includes a request-for-participation receiving means for receiving a request for participation in multi-user talking, from a terminal of a viewer. The multi-user talking apparatus also includes a participant management means and a mixing means. The participant management means manages a transmission source

address of a request for participation received by the request-for-participation receiving means, when the source transmission address is managed by the viewer management means. The mixing means receives through the network, respective pieces of talking data from terminals of viewers who have transmission source addresses managed by the participant management means, and mixes the pieces of talking data received to generate multi-user talking data. The multi-user talking apparatus also includes a multi-user data distribution means for distributing the multi-use talking data generated by the mixing means to transmission source addresses managed by the participant management means, through the network. Further, in the present invention, the request for viewing includes designation of the content that the viewer wishes to view. Even further, the viewer management means manages requests for viewing including a designation of respective contents, classifying the requests under the respective contents, and associating the requests with respective transmission source addresses of the requests. Still even further, in the present invention, the content distribution means distributes contents that are associated with respective transmission source addresses by the viewer management means, to the respective transmission source addresses associated with the contents through the network. Also, the present invention includes where the participant management means manages a transmission source address of a request for participation, associating the transmission source address with a content that is associated with the transmission source address by the viewer management means. The present invention also includes were the mixing means generates multi-user talking data for

each content managed by the participant management means, by receiving pieces of talking data respectively from terminals of viewers having transmission source addresses associated with the content, and by mixing the pieces of talking data received, to generate the multi-user talking data. In addition, the present invention provides where the multi-user talking data distribution means distributes the multi-user talking data generated for each content by the mixing means, to transmission source addresses associated with the content in question by the participant management means, through the network. The prior art does not disclose all these features.

The above described features of the present invention, as now more clearly recited in the claims, are not taught or suggested by any of the references of record. Specifically, the features are not taught or suggested by either Ellis or DeWeese, whether taken individually or in combination with each other in the manner suggested by the Examiner.

Ellis discloses an interactive television program guide system and method. However, there is not teaching or suggestion in Ellis of the multi-user talking system and method of multi-user talking as recited in claim 1, and as similarly recited in claim 9.

The Ellis system provides interactive television program guide features and other features and information related to a specific user interest or programming category in niche hubs. All of the television programming features, provided by user television equipment, that relate to a specific user interest or programming category

may be accessed from the niche hub. For example, a movie lover's niche hub may provide programming features such as television program listings for movies, video-on-demand listings for movies, pay-per-view listings for movies, web site links related to movies, movie-related merchandise, movie news groups, etc. The programming features of the niche hubs may be transmitted from a server, database, or other storage facility via a television distribution facility. User television equipment may be connected via two-way communications paths to transmit messages to each other.

A feature of the present invention, as recited in claim 1, and as similarly recited in claim 9, includes a multi-user talking control apparatus, which further includes a participant management means that manages a transmission source address of a request for participation received by the request-for-participation receiving means, when the transmission source address is managed by the viewer management means. Ellis does not teach this feature. The Examiner cites DeWeese to support the assertion that Ellis discloses this feature. However, as previously discussed, to anticipate a claim, a *single reference* must teach every element of the claims. Regarding Ellis, the Examiner cites Fig. 1B, item 36, Fig. 1C, items 50 and 52, and paragraphs [0092] and [0097] to support the assertion that Ellis discloses a multi-user talking control apparatus, and further cites Fig. 50, asserting that the multi-user control apparatus "allows viewers to chat with particular groups or specific genres or programs." However, none of the cited text and/or drawings discloses where the multi-user control apparatus includes a participant management

means that manages a transmission source address of a request for participation, in the manner claimed. Furthermore, it appears that the Examiner concedes that Ellis does not disclose this feature based the Examiner's improper reliance upon DeWeese.

Another feature of the present invention, as recited in claim 1 and as similarly recited in claim 9, includes where the viewer management means manages requests for viewing by designating respective contents, classifying the requests under the respective contents, and associating the requests with respective transmission source addresses of the requests. As conceded by the Examiner, Ellis does not disclose this feature (see rejection of original claim 8 (now canceled) on page 10, line 17 of the Office Action).

Yet another feature of the present invention, as recited in claim 1 and as similarly recited in claim 9, includes where the content distribution means distributes contents associated with respective transmission source addresses by the viewer management means, to the respective transmission source addresses associated with the contents through the network. As conceded by the Examiner, Ellis does not disclose this feature (see rejection of original claim 8 (now canceled) on page 10, line 17 of the Office Action).

Still yet another feature of the present invention, as recited in claim 1 and as similarly recited in claim 9, includes where the participant management means manages a transmission source address of a request for participation, by associating the transmission source address with a content that is associated with the

transmission source address by the viewer management means. Based on the Examiner's reliance upon DeWeese to teach this feature, it appears that the Examiner concedes that Ellis does not disclose this feature (see rejection of original claim 8 (now canceled) on page 10, lines 1-16 of the Office Action).

Another feature of the present invention, as recited in claim 1 and as similarly recited in claim 9, includes where the mixing means generates multi-user talking data for each content managed by the participant management means, by receiving pieces of talking data respectively from terminals of viewers having transmission source addresses associated with the content, and by mixing the pieces of talking data received, to generate the multi-user talking data. Based on the Examiner's reliance upon DeWeese to teach this feature, it appears that the Examiner concedes that Ellis does not disclose this feature (see rejection of original claim 8 (now canceled) on page 10, lines 1-16 of the Office Action).

Therefore, Ellis fails to teach or suggest "participant management means that manages a transmission source address of a request for participation received by said request-for-participation receiving means, when said transmission source address is managed by said viewer management means" as recited in claim 1, and as similarly recited in claim 9.

Furthermore, Ellis fails to teach or suggest "wherein said viewer management means manages requests for viewing by designating respective contents, classifying said requests under said respective contents, and associating said requests with

respective transmission source addresses of said requests" as recited in claim 1, and as similarly recited in claim 9.

Even further, Ellis fails to teach or suggest "wherein said content distribution means distributes contents that are associated with respective transmission source addresses by said viewer management means, to said respective transmission source addresses associated with said contents, through said network" as recited in claim 1, and as similarly recited in claim 9.

Yet even further, Ellis fails to teach or suggest "wherein said participant management means manages a transmission source address of a request for participation, associating said transmission source address with a content that is associated with said transmission source address by said viewer management means" as recited in claim 1, and as similarly recited in claim 9.

Furthermore, Ellis fails to teach or suggest "wherein said mixing means generates multi-user talking data for each content managed by said participant management means, by receiving pieces of talking data respectively from terminals of viewers having transmission source addresses associated with said content, and by mixing said pieces of talking data received, to generate said multi-user talking data" as recited in claim 1, and as similarly recited in claim 9.

The above noted deficiencies of Ellis are not supplied by any of the other references of record, particularly DeWeese. Therefore, combining the teachings of DeWeese with Ellis still fails to teach or suggest the features of the present invention as now more clearly recited in the claims.

DeWeese teaches a television chat system. However, there is no teaching or suggestion in DeWeese of the multi-user talking system and method of multi-user talking as recited in claim 1, and as similarly recited in claim 9.

The DeWeese television chat system allows viewers to engage in real-time communication in chat groups with other television viewers, while watching television. Users of the television chat system may engage in real-time communications with other users who are currently watching the same program or channel. The system transmits real-time communications in a chat group between users at user television equipment devices via a television distribution facility. The television chat system permits users to join chat groups related to television programs, channels, or categories of programs that the user may be interested in. The real-time communications may be textual messages, audio communications, or video communications. In addition the system may also allow users to send chat requests to ask other users to enter a chat group. The system also permits users to establish chat groups that television viewers are permitted to join, and may be based on an interactive program guide or set-top box application implemented on a set-top box.

A feature of the present invention, as recited in claim 1, and as similarly recited in claim 9, includes a multi-user talking control apparatus, which further includes a participant management means that manages a transmission source address of a request for participation received by the request-for-participation receiving means, when the transmission source address is managed by the viewer

management means. DeWeese does not teach this feature. The Examiner relies upon DeWeese to support the assertion that Ellis discloses this feature. However, as previously discussed, to anticipate a claim, a *single reference* must teach every element of the claims. Regarding DeWeese, the Examiner cites Figs. 2A, 10, 4 (item 138), and 6 (item 164) to support the assertion that this feature is disclosed. However, none of the cited drawings or the accompanying text discloses where the multi-user control apparatus includes a participant management means that manages a transmission source address of a request for participation, if the transmission source address is managed by the viewer management means, in the manner claimed. For example, as described in paragraph [0076], Fig. 4, item 138 shows an optional unique user identification code that helps the system distinguish the user from other users at the same television equipment device when receiving a real-time communication or chat request from the outside. This user identification code is quite different from a transmission source address of a request for participation. Furthermore, this is not the same as managing a transmission source address of a request for participation, if the transmission source address is managed by the viewer management means in the manner claimed. By way of further example, as described in paragraph [0081], Fig. 6 shows where a non-household user's name may be entered in box 162 and the non-household user's address may be entered in box 164. The user address is a unique identifier assigned to a particular user that allows a chat server to transmit real-time communications and chat requests to the proper recipient. This user address is quite different from a

transmission source address of the present invention. Furthermore, this is not the same as managing a transmission source address of a request for participation, if the transmission source address is managed by the viewer management means in the manner claimed.

Another feature of the present invention, as recited in claim 1 and as similarly recited in claim 9, includes where the viewer management means manages requests for viewing by designating respective contents, classifying the requests under the respective contents, and associating the requests with respective transmission source addresses of the requests. As conceded by the Examiner, DeWeese does not disclose this feature (see rejection of original claim 8 (now canceled) on page 10, line 17 of the Office Action).

Yet another feature of the present invention, as recited in claim 1 and as similarly recited in claim 9, includes where the content distribution means distributes contents associated with respective transmission source addresses by the viewer management means, to the respective transmission source addresses associated with the contents through the network. As conceded by the Examiner, DeWeese does not disclose this feature (see rejection of original claim 8 (now canceled) on page 10, line 17 of the Office Action).

Still yet another feature of the present invention, as recited in claim 1 and as similarly recited in claim 9, includes where the participant management means manages a transmission source address of a request for participation, by associating the transmission source address with a content that is associated with the

transmission source address by the viewer management means. DeWeese does not teach this feature. To support the assertion that DeWeese discloses this feature, the Examiner cites Figs. 14, 15 and 19, and states that the participant management means of DeWeese "manages a transmission source address of a user requesting to participate" (see rejection of original claim 8 (now canceled) on page 10, lines 1-16 of the Office Action). However, managing a transmission source address of a user and managing a transmission source address of a request for participation are quite different, and neither the cited figures nor the associated text teach or suggest where the participant management means manages a transmission source address of a request for participation by associating the transmission source address with a content that is associated with the transmission source address management means, as in the present invention.

Another feature of the present invention, as recited in claim 1 and as similarly recited in claim 9, includes where the mixing means generates multi-user talking data for each content managed by the participant management means, by receiving pieces of talking data respectively from terminals of viewers having transmission source addresses associated with the content, and by mixing the pieces of talking data received, to generate the multi-user talking data. DeWeese does not disclose this feature. To support the assertion that DeWeese teaches this feature, the Examiner cites paragraphs [0102] to [0105] (see rejection of original claim 8 (now canceled) on page 10, lines 1-16 of the Office Action). Contrary to the Examiner's assertions, DeWeese does not disclose a mixing means that generates multi-user

talking data by receiving pieces of talking data from terminals of viewers having transmission source addresses associated with the content, in the manner claimed.

Therefore, DeWeese fails to teach or suggest "participant management means that manages a transmission source address of a request for participation received by said request-for-participation receiving means, when said transmission source address is managed by said viewer management means" as recited in claim 1, and as similarly recited in claim 9.

Furthermore, DeWeese fails to teach or suggest "wherein said viewer management means manages requests for viewing by designating respective contents, classifying said requests under said respective contents, and associating said requests with respective transmission source addresses of said requests" as recited in claim 1, and as similarly recited in claim 9.

Even further, DeWeese fails to teach or suggest "wherein said content distribution means distributes contents that are associated with respective transmission source addresses by said viewer management means, to said respective transmission source addresses associated with said contents, through said network" as recited in claim 1, and as similarly recited in claim 9.

Yet even further, DeWeese fails to teach or suggest "wherein said participant management means manages a transmission source address of a request for participation, associating said transmission source address with a content that is associated with said transmission source address by said viewer management means" as recited in claim 1, and as similarly recited in claim 9.

Furthermore, DeWeese fails to teach or suggest "wherein said mixing means generates multi-user talking data for each content managed by said participant management means, by receiving pieces of talking data respectively from terminals of viewers having transmission source addresses associated with said content, and by mixing said pieces of talking data received, to generate said multi-user talking data" as recited in claim 1, and as similarly recited in claim 9.

IV. Rakib Does Not Teach or Suggest Every Element of the Claims

Independent claims 1 and 9 were amended to include the features of original claim 8 (now canceled). The Examiner further relied upon U.S. Patent No. 6,889,385 to Rakib, et al. ("Rakib") in an obviousness rejection of canceled claim 8. Therefore, Applicants provide the following remarks regarding Rakib.

The above noted deficiencies of Ellis and DeWeese are not supplied by any of the other references of record, particularly Rakib. Therefore, combining the teachings of Rakib with DeWeese and Ellis still fails to teach or suggest the features of the present invention as now more clearly recited in the claims.

Rakib discloses a home network for receiving video-on-demand and other requested programs and services. However, there is no teaching or suggestion in Rakib of the multi-user talking system and method of multi-user talking as recited in claim 1, and as similarly recited in claim 9.

The Rakib system provides video-on-demand services, broadband Internet access and other broadband services over T-carrier systems, including a pull multiplexer cherry picker at the head end. The pull multiplexer receives upstream

requests and cull out MPEG or other compressed video packets, IP packets and other data packet types to satisfy the requests or to send pushed programming downstream. The downstream can be DSL or HFC. Each customer has a cable modem, DSL modem or a gateway that interfaces multiple signal sources to a LAN to which settop decoders, digital phones, personal computers, digital fax machines, video cameras, digital VCRs, etc. can be attached. Each gateway can couple the LAN to a DSL line or HFC through a cable modem or a satellite dish through a satellite transceiver. A PSTN and conventional TV antenna interface is also provided.

A feature of the present invention, as recited in claim 1, and as similarly recited in claim 9, includes a multi-user talking control apparatus, which further includes a participant management means that manages a transmission source address of a request for participation received by the request-for-participation receiving means, when the transmission source address is managed by the viewer management means. Rakib does not disclose this feature.

Another feature of the present invention, as recited in claim 1 and as similarly recited in claim 9, includes where the viewer management means manages requests for viewing by designating respective contents, classifying the requests under the respective contents, and associating the requests with respective transmission source addresses of the requests. Rakib does not disclose this feature. To support the assertion that Rakib discloses this feature, the Examiner cites Figs. 1 (item 10), 4, 5A (item 348), 5D (item 406) and column 9, lines 42-67. However, the neither the

cited drawings nor the cited text discloses the claimed features. For example, column 9, lines 8-67 describes the head end multiplexer or cherry picker 10 shown in Fig. 1. As more specifically described in column 9, lines 9-11, the cherry picker 10 merely receives one or more input data streams of any type of data. This is quite different from managing requests for viewing by designating respective contents, classifying the requests under the respective contents, and associating the requests with respective transmission source addresses of the requests, in the manner claimed.

Yet another feature of the present invention, as recited in claim 1 and as similarly recited in claim 9, includes where the content distribution means distributes contents associated with respective transmission source addresses by the viewer management means, to the respective transmission source addresses associated with the contents through the network. Rakib does not disclose this feature. To support the assertion that Rakib discloses this feature, the Examiner cites Figs. 1-3, 5A (item 348), 5D (item 406), and column 9, lines 42-67. However, neither the cited drawings nor the cited text discloses the claimed features. For example, there is no disclosure in Rakib of distributing contents to respective source addresses associated with the contents, where the contents are associated with respective source addresses by a viewer management means, in the manner claimed.

Still yet another feature of the present invention, as recited in claim 1 and as similarly recited in claim 9, includes where the participant management means manages a transmission source address of a request for participation, by associating

the transmission source address with a content that is associated with the transmission source address by the viewer management means. Rakib does not disclose this feature.

Another feature of the present invention, as recited in claim 1 and as similarly recited in claim 9, includes where the mixing means generates multi-user talking data for each content managed by the participant management means, by receiving pieces of talking data respectively from terminals of viewers having transmission source addresses associated with the content, and by mixing the pieces of talking data received, to generate the multi-user talking data. Rakib does not disclose this feature.

Therefore, Rakib fails to teach or suggest "participant management means that manages a transmission source address of a request for participation received by said request-for-participation receiving means, when said transmission source address is managed by said viewer management means" as recited in claim 1, and as similarly recited in claim 9.

Furthermore, Rakib fails to teach or suggest "wherein said viewer management means manages requests for viewing by designating respective contents, classifying said requests under said respective contents, and associating said requests with respective transmission source addresses of said requests" as recited in claim 1, and as similarly recited in claim 9.

Even further, Rakib fails to teach or suggest "wherein said content distribution means distributes contents that are associated with respective transmission source

addresses by said viewer management means, to said respective transmission source addresses associated with said contents, through said network" as recited in claim 1, and as similarly recited in claim 9.

Yet even further, Rakib fails to teach or suggest "wherein said participant management means manages a transmission source address of a request for participation, associating said transmission source address with a content that is associated with said transmission source address by said viewer management means" as recited in claim 1, and as similarly recited in claim 9.

Furthermore, Rakib fails to teach or suggest "wherein said mixing means generates multi-user talking data for each content managed by said participant management means, by receiving pieces of talking data respectively from terminals of viewers having transmission source addresses associated with said content, and by mixing said pieces of talking data received, to generate said multi-user talking data" as recited in claim 1, and as similarly recited in claim 9.

Ellis, DeWeese and Rakib each suffer from the same deficiencies relative to the features of the present invention, as recited in the claims. Therefore, combining the teachings of Ellis and DeWeese in the manner suggested by the Examiner, or and combining the features of Ellis, DeWeese and Rakib, does not render obvious the features of the present invention, as now more clearly recited in claims 1-3 and 9. Accordingly, reconsideration and withdrawal of the 35 U.S.C. §102(e) rejection of claims 1-3 and 9 as being anticipated by Ellis (while improperly relying upon DeWeese) are respectfully requested.

The remaining references of record have been studied. Applicants submit that they do not supply any of the deficiencies noted above with respect to the references used in the rejection of claims 1-3 and 9.

35 U.S.C. §103 Rejections

Claims 4 and 8 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Ellis in view of Rakib. As indicated above, claim 8 was canceled. Therefore, this rejection with regard to claim 8 is rendered moot. This rejection with regard to the remaining claim 4 is traversed for the following reasons. Claim 4 is dependent on claim 1. Therefore, Applicants submit that claim 4 is allowable for at least the same reasons previously discussed regarding independent claim 1.

In view of the foregoing amendments and remarks, Applicants submit that claims 1-7, 9 and 10 are in condition for allowance. Accordingly, early allowance of such claims is respectfully requested.

To the extent necessary, Applicants petition for an extension of time under 37 CFR 1.136. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, or credit any overpayment of fees, to the deposit account of Mattingly, Stanger, Malur & Brundidge, P.C., Deposit Account No. 50-1417 (referencing attorney docket no. 566.40875X00).

Respectfully submitted,

MATTINGLY, STANGER, MALUR & BRUNDIDGE, P.C.

Donna K. Mason

Donna K. Mason
Registration No. 45,962

DKM/sdb
(703) 684-1120